

REMARKS

This is in response to the outstanding Office Action, Paper No. 13, dated December 15, 2003, which finally rejected all remaining claims 1-6 and 27-39 under 35 USC 102(b) as being anticipated by WO 96/28258 to Davies. Applicants thank the Examiner for the careful review of the instant application and request reconsideration based on the above amendments and remarks below.

By the foregoing Amendment, Applicants have herein incorporated the subject matter of claim 38, regarding a substantially continuous coating, into claim 1 and have cancelled claim 38 without prejudice. Applicants respectfully submit that claim 1, as amended, is not anticipated nor made obvious by Davies, and is in fact taught away from by Davies. Further, Applicants respectfully traverse the Examiner's determination that claim 1 is unpatentable because the product claimed in claim 1 is not structurally identical to the product in Davies as required by MPEP 2113 for a product-by-process claim.

As stated in MPEP 2113, first paragraph, the determination of patentability of a product-by-process claim is based on the product itself. Further, as stated in MPEP 2113, third paragraph,

“the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.”

In re Garnero, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). Also, the Applicant may overcome the Examiner's rejection by “providing evidence establishing an unobvious difference between the claimed product and the prior art product.” *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983).

As noted throughout Davies, including at page 10, lines 10-16, Davis uses a dry powder coating technique, and therefore melts the coating to hold the coating on the sheath. During this melting, Davies describes that it forms a discontinuous covering, which provides low bulk and low bending rigidity. Conversely, Applicants' invention is aimed toward applying a wet slurry and drying the slurry to get a better coating. Davies further teaches away from the claimed invention at page 4, lines 3-13 and page 5 line 18-page 6, line 2, where he distinguishes his product, with the discontinuous layer formed by dry powder coating, from a product made using a wet powder coating process, as is Applicants' unmelted coating.

Thus, the composite roving formed in claim 1 (having a substantially continuous coating surrounding the outer fibers) is structurally different than the product formed in Davies (which forms a discontinuous coating). Further, as one of ordinary skill in the art readily recognizes, the difference between a substantially continuous coating and a discontinuous coating is an unobvious structural difference. By definition, a discontinuous coating has a coating that is “not continuous”. Conversely, the word substantially, according to its ordinary dictionary definition, describes something to “a large degree”. Thus, a substantially continuous coating is to a large degree a continuous coating, and as such specifically excludes a discontinuous coating, contrary to the Examiner’s analysis on Page 2 of the Office Action. Further, a discontinuous coating could never be considered continuous in any fashion. Similarly, with respect to claim 39, a substantially unmelted coating specifically excludes a melted powder coating.

Thus, in accordance with MPEP 2113 and *In re Garnero*, as claim 1 requires a substantially continuous coating, which Davies does not disclose or contemplate, claim 1 is allowable over Davies. Similarly, claims 2-6, 27-37, and 39, which depend from claim 1, are also allowable. Reconsideration of claim 1, and dependent claims 2-6, 27-37 and 39, is therefore respectfully requested.

Conclusion

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the rejections is requested. Allowance of claims 1-6, 27-37 and 39 at an early date is solicited. If any questions should arise with respect to the above Remarks, or if the Examiner has any comments or suggestions to place the claims in better condition for allowance, it is requested that the Examiner contact Applicant’s attorney at the number listed above.